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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Reissue Application of:
Dario Sansone et al.

Application No.: 10/659,794
Filed: September 11, 2003
For: Vehicle with Retractable and Steerable Rear Wheel
Group Art Unit: 3611
Examiner: Kevin Hurley
Confirmation No.: 4545

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PROTEST UNDER 37 C.F.R. § 1.291

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTENTION: Director Technology Center 3600

Wirtgen America, Inc. herein protests the issuance of claims 115, 116 and 122-146 of Reissue Application 10/659,794 ("794 Reissue Application"). This is the first protest submitted in the '794 Reissue Application by Wirtgen America, Inc. Protestor requests that receipt of this protest be acknowledged by stamping and returning the enclosed self-addressed postcard.

The "Listing Of The Information On Which The Protest Is Based" and the "Concise Explanation Of The Relevance Of Each Grounds Of Protest" set forth below are submitted in compliance with the requirements of 37 CFR 1.291(c)(1) and (2). Because these grounds of protest are not based upon prior art information, there are no copies or translations to be provided per 37 CFR 1.291(c)(3) and (4). All of the facts discussed herein are already of record in the file history of the parent patent and of this reexamination proceeding.

Listing Of The Information On Which The Protest Is Based

The grounds for this protest are:

- (1) claims 122-146 as newly presented by Applicant in the Reply to Office Action dated August 7, 2009 are not patentable because they recapture subject matter surrendered during prosecution of U.S. Patent No. 6,286,615 ("615 Patent"), and they are not "narrowed" (materially or otherwise) with regards to any "overlooked" aspect of the invention; and
- (2) claims 115 and 116 are not patentable because they are improper dependent claims that delete elements required by their parent claims.

Concise Explanation Of The Relevance Of Each Grounds Of Protest

I. CLAIMS 122 - 146

1. The Change To Steering "Only One" Rear Support Is A Broadening Change, Not A Narrowing Change.

Applicant's entire case for the allowance of new reissue claims 122-146 is that these claims satisfy the third step of the test for recapture analysis, namely that claims which would otherwise be objectionable because they recapture surrendered subject matter can be allowed if they are materially narrowed with regard to an overlooked aspect of the invention.

The sole feature that Applicant has argued as providing a material narrowing of the claims is the change regarding the number of rear supports which must be steered. Applicant has argued at page 23 of the REPLY TO OFFICE ACTION filed on August 7, 2009 that:

“This aspect that only one of the rear supports is steerable is an overlooked aspect of the invention, in that this aspect is not included in any of the claims of the original patent, and was not included in any claim during the prosecution of the original patent. Each of the claims of the original patent require both of the rear supports to be steerable or maneuverable.”

But the point that Applicant overlooks is that this change requiring “only one” instead of both rear supports to be steerable, broadens the reissue claims as compared to the patent claims.

“A claim of a reissue application is broader in scope than the original claims if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent.” *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n. 2 (Fed. Cir., 1987); see also *Brady Const. Innovations, Inc. v. Perfect Wall, Inc.*, 290 Fed. Appx. 358, 363 (Fed. Cir., 2008). “The first step in applying the recapture rule is to determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation’s aspect.” *In re Clement*, 131 F.3d 1464 at 1468, 45 USPQ2d 1161 at 1164 (Fed. Cir., 1997).

As Applicant itself has so emphatically stated, the original patent claims required both rear supports to be steerable; they did not cover the case of only one rear support being steerable. The proposed reissue claims do cover the case of only one

rear support being steerable, and thus the change to the claims is a broadening of the claims, not a narrowing.

A broadening change by definition cannot be a “materially narrowing” change and cannot satisfy the third step of the recapture test.

2. The Number Of Rear Supports To Be Steered Was Not “Overlooked”; It Was An Express Aspect Of The Original Prosecution.

Furthermore, this issue was not “overlooked” in the original prosecution. The issue of the number of rear supports to be steered was the express subject of the arguments made during prosecution which created the surrender of claim scope that is now being recaptured. As noted by Examiner in the Office Action dated February 10, 2009, Applicant surrendered this subject matter by argument in the amendment dated May 15, 2001. Specifically at page 8 of that amendment Applicant argued that claims 12- 14 (claims 9- 11 of the issued patent) of the ‘565 Application were patentable over the prior art:

“because the prior art lacks a steerable machine having a pair of rollable front supports that are rotatable about a front vertical axis and are controlled by power steering. The prior art also lacks a pair of rollable rear supports that are pivotable about a rear vertical axis and are controlled by a steering hydraulic cylinder.” (emphasis added).

An aspect of the claims which was the express subject of the original prosecution cannot qualify as “overlooked”.

“[A] material narrowing in an overlooked aspect cannot possibly relate to surrendered subject matter since this subject matter, having been claimed and then

surrendered during original prosecution, could not have been overlooked.” *Ex Parte Bradford W. Beale* (Appeal 2007-1432 Bd. Pat. App. & Int. August 2007) at *17, citing for authority *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir., 2005), *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366 (Fed. Cir., 2001), and *Hester Industries Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir., 1998).

II. CLAIMS 115 - 116

A dependent claim must include all of the elements of the claim from which it depends and add some further limitation. A dependent claim cannot subtract or eliminate an element of the claim from which it depends. As set forth in M.P.E.P. section 608.01(n), part III:

“The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

Claim 115 purports to depend from claim 1. Claim 1 requires that the maneuvering system be one “for rotating said rear supports about the rear vertical axis”. Claim 115 improperly attempts to eliminate the requirement of claim 1 that both rear supports be rotatable and instead says that “only one of the rear supports ... is configured to be rotatable about the rear vertical axis...”. Claim 115 eliminates the requirement of claim 1 that the second rear support be rotatable.

Claim 116 purports to depend from claim 9. Claim 9 requires “said rear supports being pivotable about a rear vertical axis ...”. Claim 116 improperly

attempts to eliminate the requirement that both rear supports be pivotable and instead says that “only one of said rear supports is pivotable about the rear vertical axis ...”. Claim 116 eliminates the requirement of claim 9 that the second rear support be pivotable.

Claims 115 and 116 should be rejected for violation of 35 U.S.C. Section 112, fourth paragraph.

Conclusion

Applicant’s argument that claims 122 – 146 are materially narrowed regarding an overlooked aspect of the invention is pure semantics. The “limitation” they have allegedly added (that “only one” rear support is steered) actually broadens the claim. Applicant’s alleged “material narrowing of an overlooked aspect” is in fact a broadening of the exact feature that was surrendered during the original prosecution. There could be no clearer example of impermissible recapture.

Applicant also is not allowed to broaden its existing claims 1 and 9 by adding dependent claims 115 and 116 which eliminate features of the parent claims.

Accordingly claims 115 – 116 and 122 – 146 should be rejected.

For: Vehicle with Retractable and Steerable Rear Wheel

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing has been furnished, via first class mail, postage prepaid, this 25th day of August, 2009, to

Applicant's attorney of record:

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